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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,474	01/28/2002	Hsiu-Chu Lin	252016-2540	4179
47390	7590	06/06/2006	EXAMINER	
THOMAS, KAYDEN, HOSTEMEYER & RISLEY LLP 100 GALLERIA PARKWAY SUITE 1750 ATLANTA, GA 30339			SALIARD, SHANNON S	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/058,474	LIN ET AL.	
	Examiner	Art Unit	
	Shannon S. Saliard	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,10,12-20,22,23,25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,10,12-20,22,23,25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant has amended claim 3 and cancelled claims 5, 9, 11, 21, 24, and 26. No new claims have been added. Thus, claims 1-4, 6-8, 10, 12-20, 22, 23, 25, and 27-31 remain pending and are presented for examination.

Response to Arguments

2. Applicant's amendments filed 15 March 2006 with respect to the rejection of claim 3 under 35 U.S.C. 112 Second Paragraph have been fully considered and are accepted. Thus, the rejection of claim 3 under 35 U.S.C. 112 Second Paragraph has been withdrawn.

3. Applicant's arguments filed 15 March 2006 have been fully considered but they are not persuasive.

4. Applicant argues (with respect to claim 1) that Pape et al does not teach or suggest "transmitting instructions from said computer to said product storage unit, said printer, and said exit control station to ship said quantity or product; transmitting product release information related to said quantity of product from said computer memory to said product storage unit, said printer, and said exit control station." Examiner submits, Pape et al teaches, "In the order-release determination, one or more of the currently pending orders and one or more of the currently available products are compared to determine whether all of the products in an order are available for shipping [0043]...manufacturing control system may determine whether all required articles for

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the order are available (for example, by reference to a database indicating how many articles of each type are present and not already allocated to another manufacturing facility" [0045]. Pape et al further discloses "the manufacturing control system then releases the order...when a parcel is released, manufacturing control system preferably prints the shipping labels to be applied to the items in the shipment...manufacturing control system preferably also transports the product that triggered the release determination (if any) and any other products for the order (including those stored in the ASRS (product storage unit)...to the parcel dock (exit control station) at which the carrier vehicle was found" [0048]. Pape et al further discloses, "The manufacturing control system also preferably includes control logic, which may be implemented as one or more control programs, subprograms, scripts, etc" [0036]. Moreover, Pape et al discloses, "upon determining that the actual box count matched the displayed box count, the carrier representative preferably scans the pallet label...manufacturing control system preferably interprets the scan as acceptance of the pallet...pallet is then moved into carrier vehicle" [0071].

5. In response to applicant's argument (with respect to claims 6-8, 15, 22, and 23) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992). In this case, Petkovsek discloses a method of releasing a product for shipping including printing a digital stamp on a form (col 9, lines 27-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pape et al to include the method disclosed by Petkovsek.

Petkovsek provides the motivation that the digital stamp aids in the delivery of non-domestic mail and provide a record for the sender and shipping authority that the mail reached its destination (col 9, lines 32-39).

6. In response to applicant's argument (with respect to claims 6-8, 15, 22, and 23) that "in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an electronic custom release slip", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. Applicant argues (with respect to claims 1 and 17) that the claimed invention and Pape et al deal with different problems. In response to applicant's argument that Pape et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24

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USPQ2d 1443 (Fed. Cir. 1992). In this case, the preambles of claims 1 and 17 in the instant application are directed to a method and system for releasing a product for shipping. The invention of Pape et al is directed to a system and method for shipping items from a distribution facility [title]. Furthermore, Pape et al discloses a system and method for order release [0040] and direct shipment of products to customers [0013].

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1, 3, 4, 10, 12, 16, 17, 19, 20, 25, and 27** are rejected under 35

U.S.C. 102(e) as being anticipated by Pape et al [US 2002/0122715].

As per **claims 1 and 17**, Pape et al discloses a method of releasing product for shipping, comprising: providing a computer having a memory and a number of user inputs (0035); providing a product storage unit (0028); providing an exit control station (0048); providing a printer (0035); providing a product release information source (0042); feeding product release information into said computer from said product release information source; storing said product release information in said computer

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memory (0048); entering a shipping request into one of said user inputs of said computer by a user wherein said shipping request comprises instructions to ship a quantity of product to a customer (0041; 0042); transmitting instructions from said computer to said product storage unit, said printer, and said exit control station to ship said quantity of product (0048); transmitting product release information related to said product storage unit, said printer, and said exit control station; printing a product release form for said quantity of product by said printer using said product release information transmitted to said printer by said computer (0048); locating said quantity of product in said product storage unit, attaching said product release form, and preparing said quantity of product for shipping; transporting said quantity of product to said exit control station (0048; 0059); verifying said quantity of product has said product release form attached and is the same quantity of product identified by shipping request at said exit control station (0071); and shipping said quantity of product if said quantity of product has said product release form attached and is the same quantity of product identified by said shipping request (0072).

As per **claims 3 and 19**, Pape et al further discloses further comprising transmitting confirmation of shipping said quantity of product or a corrective action taken to said computer (0048; 0077).

As per **claims 4 and 20**, Pape et al further discloses wherein said product storage unit is a warehouse (0045).

As per **claims 10 and 25**, Pape et al further discloses wherein said verifying said quantity of product has said release form attached and is said quantity of product

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identified by said instructions is accomplished using an electronic scanning system (0071).

As per **claims 12 and 27**, Pape et al further discloses wherein said transmitting said confirmation of shipping said quantity of product or said corrective action taken is accomplished using a data terminal connected to said computer (0048).

As per **claim 16**, Pape et al further discloses wherein said user is an employee of a unit producing said quantity of product (0041).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 2 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pape et al [US 2002/0122715] in view of Duncan et al [US 2003/0083890].

As per **claims 2 and 18**, Pape et al discloses all the limitations of claim 1. Pape et al does not disclose further comprising taking corrective action if said quantity of product does not have said product release from attached or is not the same said quantity of product identified by said shipping request. However, Duncan et al discloses a method of releasing product for shipping in which corrective action is taken when the

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shipping quantity does not match the ordered quantity of a product (0037). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pape et al to include the method disclosed by Duncan et al for the quality assurance and customer satisfaction by ensuring that the customer receives the product that was ordered.

10. **Claims 13, 14, and 28-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pape et al [US 2002/0122715].

As per **claims 13, 28, and 29**, Pape et al discloses all the limitation of claim 1. Pape et al fails to explicitly disclose wherein said product release source is a magnetic disk. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the capability of loading product source information from a magnetic disk to avoid manually inputting product release information into the computer.

As per **claims 14, 30, and 31**, Pape et al fails to explicitly disclose wherein said product release information source is a compact disk. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the capability of loading product source information from a compact disk to avoid manually inputting product release information into the computer.

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11. **Claims 6-8, 15, 22, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pape et al [US 2002/0122715] in view of Petkovsek [U.S. Patent No. 6,863,310].

As per **claim 6, 7, and 22**, Pape et al discloses all the limitations of claim 1. Pape et al does not disclose wherein said transmitting said product release information to said printer includes instructions to print a digital stamp on said product release form. However, Petkovsek discloses a method of releasing a product for shipping including printing a digital stamp on a form (col 9, lines 27-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pape et al to include the method disclosed by Petkovsek. Petkovsek provides the motivation that the digital stamp aids in the delivery of non-domestic mail and provide a record for the sender and shipping authority that the mail reached its destination (col 9, lines 32-39).

As per **claims 8 and 23**, Pape et al does not disclose wherein said product release form includes a customs declaration. However, Petkovsek discloses a method for releasing a product, which includes providing a customs declaration form (col 5, lines 31-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pape et al to include the method disclosed by Petkovsek. Petkovsek provides the motivation that providing the customs declaration on the label of the mail in conjunction with the other necessary mail information allows the sender to complete one single form for delivery of the item (col 3, lines 35-38).

As per **claim 15**, Pape et al does not disclose wherein said product release information includes information required to produce a digital stamp and a customs declaration form. However, Petkovsek discloses a method for releasing a product, which includes providing a customs declaration form and digital stamp (col 5, lines 31-44; col 9, lines 27-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pape et al to include the method disclosed by Petkovsek. Petkovsek provides the motivation that providing the customs declaration and digital stamp on the label of the mail in conjunction with the other necessary mail information allows the sender to complete one single form for delivery of the item (col 3, lines 35-38).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon S. Saliard whose telephone number is 571-272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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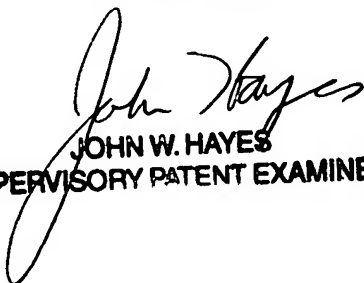
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SSS

Shannon S Saliard
Examiner
Art Unit 3639


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER